THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIO KOBAYASHI,
RYOICHI NAKATANI,
HITOSHI NAKAMURA
and NORIYUKI KUMASAKA

Appeal No. 95-4189
Application 07/534,872[1]

HEARD: DECEMBER 9, 1997

Before KIMLIN, WEIFFENBACH and WARREN, *Administrative Patent Judges*.

WEIFFENBACH, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-6 and 12-25 which are the only claims remaining in the application. We reverse.

[1] Application for patent filed June 8, 1990.

The Claimed Subject Matter

The claims on appeal are directed to magnetic flux density film. Claim 1 is illustrative of the claimed subject matter:

> 1. A heat resistant, high saturation magnetic flux density film, comprising a single layer containing a plurality of crystal grains of ferromagnetic metal, and carbide positioned around each of said plurality of crystal grains.

The Rejection

Claims 1-6 and 12-25 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the term "film" referred to in appellants' specification is, in actuality, comprised of several laminated sub-layers .[2]

Opinion

We have carefully considered the respective positions advanced by appellants and the examiner. For the reasons set forth below, we will reverse the examiner's rejection under 35 U.S.C. § 112, first paragraph.

The function of the 35 U.S.C. § 112, first paragraph, written description requirement is to ensure that the inventors have possession, as of the filing date of the application, of the specific subject matter later claimed. *In re Edwards,* 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). To comply with this

[2] The final rejection included other rejections. Claims 7-11 and 26-31 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kobayashi et al (Patent No. 4,920,013). The same claims were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-9 of Patent No. 4,920,013. These rejections were rendered moot by the cancellation of the rejected claims. See Paper No. 15.

requirement, it is not necessary that the invention be claimed using the same words as in the specification. All that is required is that the specification reasonably convey to a person of ordinary skill in the art that as of the filing date of the application, the inventors had possession of the subject matter later claimed. *In re Edwards*, 568 F.2d at 1351-52, 196 USPQ at 467; *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96; *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The determination as to whether the specification provides support for the newly claimed subject matter is primarily factual and depends on the nature of the invention and the amount of knowledge imparted by the disclosure to those of ordinary skill in the art. *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96. The examiner has the initial burden of presenting evidence or reasoning as to why one of ordinary skill in the art would not have recognized in the specification a description of the invention as later claimed.

Claim 1 recites a "film" comprising a "single layer containing a plurality of [ferromagnetic] crystal grains" having a carbide "positioned around each of said plurality of crystal grains." The only other independent claim, claim 2, is the same as claim 1 except that a boride is "positioned around each of said plurality of crystal grains." In the summary of the invention, appellants state on page 3, lines 18-23 of the specification that

> In order to achieve [a high saturated magnetic flux density film] ..., there is provided a heat resistant, high saturation magnetic flux density film comprising a plurality of crystal grains of ferromagnetic metal, and carbide or boride positioned around each

of said plurality of crystal grains. [Emphasis ours.]

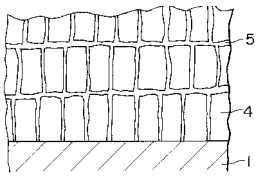
Fig. 2 of the application shows a plurality of ferromagnetic grains, each surrounded by a carbide or boride material. The examiner recognized this, but noted that the only reference to Fig. 2 is in Example 2 at page 19, lines 20-26 of appellants' specification and that in discussing the product formed, appellants refer to a laminated structure. The examiner relies on a Webster's Dictionary definition of "laminated" as meaning "composed of or built in thin sheets or layers" (answer, p. 4). The examiner concludes from all this that the "film" is really a laminated structure comprising single layers.

We disagree with the examiner's conclusion. The laminated films formed by appellant comprise crystal grains surrounded by a boride or carbide as recited in appellants' claims.

Appellants disclose the following at page 19, lines 13-26 of the specification:

> The inventors analyzed the above-described ferromagnetic metal laminated films by a high resolution EPMA [Electron Probe Micro Analysis] method. As a result, in the position of the metal layer disposed between adjacent two ferromagnetic layers there was gathered carbon or boron added to the ferromagnetic layer film, that is, it can be considered that carbide or boride were formed therein. Furthermore, it was confirmed that a portion of the interposed metal was diffused and, distributed so as to surround, as shown in Fig. 2, each of the crystal grains 4 which form the ferromagnetic film. Since carbon or boron was present in the surrounding portion 5, it can be considered that they are present in the form of carbide or boride.

Fig. 2 is reproduced below

We find that the 

appellants' specification would have conveyed sufficient knowledge to one skilled in the art of the subject matter set forth in the appealed cliams. The examiner has not met the burden of establishing why one of ordinary skill in the art would not have recognized in the specification a description of the invention as later claimed. The examiner acknowledges that Fig. 2 does show ferromagnetic grains mixed with boride/carbide materials. While appellants do refer to a "laminated structure," one skilled in the art would have understood from appellants' disclosure that the laminated structure can be a single layer comprising a plurality of grains surrounded by a boride or carbide material. The Examiner's comments regarding Example 3 as supporting a laminated structure are noted. However, appellants state that an EPMA analysis of the product formed in accordance with Example 3 showed that the "carbide or boride was present in such a manner that they surrounded the crystal grains forming the ferromagnetic film similarly to Example 2" (specification, p. 22, lines 1-10).

For the reasons given above, the examiner's rejection of claims 1-6 and 12-25 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	))))) BOARD OF PATENT
CAMERON WEIFFENBACH Administrative Patent Judge	) APPEALS AND) INTERFERENCES
CHARLES F. WARREN Administrative Patent Judge	)))))

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